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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,835	09/18/2001	Monica A. Jacinto	7784-000255	8137

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EXAMINER
WESSMAN, ANDREW E

ART UNIT	PAPER NUMBER
1742	3

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/954,835	JACINTO ET AL.	
	Examiner	Art Unit	
	Andrew E Wessman	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☒ Claim(s) *1, 7, 14, 20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 1, 7, 14, and 20 are objected to because of the following informalities:

In claim 1, "burn resistance" should be "burn resistant".

In claims 7 and 14 "silicone" is thought to be a misspelling of "silicon". Silicone is a materially different substance, and so correction or clarification is required.

In claim 20, "further comprising" should be inserted between "19" and "manganese".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-22 are indefinite because an alloy without proportions for its alloying elements is indefinite. See Koebel v. Coe (41 USPQ 759).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. Patent No. 5,120,373).

Miller et al. anticipates the invention as claimed. Miller et al. discloses (col. 2, lines 5-23, Table 1) a nickel based alloy comprising 12-20 wt% chromium, 10-20 wt% cobalt, 3-7 wt% titanium, and 1.2-3.5 wt% aluminum. Miller et al. further discloses the alloy can contain up to 0.25 wt% carbon, up to 1.0 wt% manganese, up to 0.8 wt% silicon, up to 0.07 wt% zirconium, and 0.0005-0.004 wt% boron. Using minimum and maximum values of the additional elements in the disclosure, the nickel content of Miller et al. can range from less than 40 wt% to approximately 72 wt%. Miller et al. also discloses (col. 1, lines 65-68) that the alloy has high strength, and provides values of the strength in figure 3.

Miller et al. does not teach that the alloy is burn resistant. The claimed invention does not claim any quantitative data about burn resistance, and all materials have some measure of burn resistance, so this is given little patentable weight. Also, because the alloy of Miller et al. has the same composition as that of the claimed invention, the properties of the alloys must be the same. Applicant has not claimed any features aside from the composition of the alloy, and so any processing that may be performed on the composition to impart different properties to the alloy can not be used as a basis for a determination of patentability. Also, it has been held that a composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655 (Fed. Cir. 1990). In this case, because

the applicant and Miller et al. teach identical compositions, the properties of those compositions must be the same. Also see Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), wherein it is held that because a composition of the prior art is identical to the claimed invention, it is immaterial what properties are claimed because those properties would necessarily be present.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (U.S. Patent No. 5,120,373).

The claimed invention teaches values outside the ranges disclosed by Miller et al. for chromium, aluminum, and titanium. However, in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art", a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). See MPEP 2144.05. In this case, the compositional ranges for the claimed elements substantially overlap or lie within the ranges disclosed by Miller et al. and so the claimed ranges would have been obvious to one of ordinary skill in the art.

Miller et al. does not teach specific pressure threshold values for the alloys. Miller et al., however, teaches (see abstract) alloys of a substantially identical composition as the claimed invention, and shows (Fig. 3) that such alloys have a tensile

strength of over 160,000 psi. While there is no mention in either reference of a specific value of threshold pressure, because Miller et al. teaches alloys with the same composition as the claimed invention, and because Miller et al. teaches that the strength properties of the prior art alloys are the same as the claimed invention, it would be expected by one of ordinary skill in the art that the threshold pressure of the alloys would also be the same. Also, when the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing they are not. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). In this case, applicant is invited to provide evidence that the claimed invention is patentably distinct from the prior art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miller et al. (U.S. Patent No. 4,844,864) teaches alloys with compositions similar to those of the claimed invention. Eiselstein et al. (U.S. Patent No. 4,788,036) discloses nickel- based alloys of similar compositions, with mention of alloy strengths.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for

the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW
August 26, 2002

GEORGE WYSZOMIERSKI
PRIMARY EXAMINER